

ESTTA Tracking number: **ESTTA668210**

Filing date: **04/22/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Medefil, Inc.
Granted to Date of previous extension	04/22/2015
Address	250 Windy Point Drive Glendale Heights, IL 60139 UNITED STATES
Attorney information	Joseph T. Nabor FITCH, EVEN, TABIN & FLANNERY, LLP 120 S. LaSalle Street Suite 1600 Chicago, IL 60603-3406 UNITED STATES trademark@fitcheven.com

Applicant Information

Application No	86338165	Publication date	12/23/2014
Opposition Filing Date	04/22/2015	Opposition Period Ends	04/22/2015
Applicant	Messias Bassile 156 Weatherstone Dr Woodstock, GA 30188 UNITED STATES		

Goods/Services Affected by Opposition


Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Platform as a service (PAAS) featuring computer software platforms for use by others for use in medical practice management, electronic health records management, revenue cycle management, and medical billing in the field of health-care; Software as a service (SAAS) services featuring software for use by others for use in medical practice management, electronic health records management, revenue cycle management, and medical billing in the field of healthcare
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3457826	Application Date	11/09/2007
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Registration Date	07/01/2008	Foreign Priority Date	NONE
Word Mark	MEDEFIL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1998/02/17 First Use In Commerce: 1998/02/17 Syringes sold filled with saline and syringes sold filled with heparin		

U.S. Registration No.	3588352	Application Date	11/05/2007
Registration Date	03/10/2009	Foreign Priority Date	NONE
Word Mark	MEDEFLUSH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2008/09/10 First Use In Commerce: 2008/09/10 Syringes sold filled with saline and syringes sold filled with heparin		

Attachments	77325534#TMSN.png(bytes) 77321652#TMSN.png(bytes) 8689-133711 MEDFIL Design.pdf(270962 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Joseph T. Nabor/
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Name	Joseph T. Nabor
Date	04/22/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Medefil, Inc.,)	
Opposer,)	
)	
v.)	Opposition No.
)	
Messias Bassile)	
)	
)	
Serial No. 86/338165)	
Filed: July 15, 2014)	
Mark: MEDFIL Design)	
Published: December 23, 2014)	

NOTICE OF OPPOSITION

Medefil, Inc., having a principal place of business at 250 Windy Point Drive, Glendale Heights, Illinois 60139 (“Medefil”) believes that it will be damaged by registration of the MEDFIL Design mark in Application No. 86/338165 by Messias Bassile, (“Applicant”) and hereby opposes the same upon the following grounds.

COUNT I: LIKELIHOOD OF CONFUSION

1. Medefil is a leading company in the field of health and medical supplies.
2. Medefil has used the inherently distinctive marks MEDEFIL and MEDEFLUSH and the Medefil trade name in connection with its business as its marks in U.S. commerce for many years.
3. Based on its lengthy and extensive use throughout the United States, Medefil owns Registration No. 3,457,826 for the mark MEDEFIL, filed November 9, 2007 and issued July 1, 2008 and presently specifying “syringes sold filled with saline and syringes sold filled with heparin” based on use beginning at least as early as 1998. A current printout of information from

the USPTO electronic database records showing the current status and title of Registration No. 3,457,826 appears in Exhibit A. This Registration is current, valid, incontestable and subsisting.

4. Based on its lengthy and extensive use throughout the United States, Medefil owns Registration No. 3,588,352 for the mark MEDEFLUSH filed November 5, 2007 and issued March 10, 2009 and presently specifying “syringes sold filled with saline and syringes sold filled with heparin.” A current printout of information from the USPTO electronic database records showing the current status and title of Registration No. 3,588,352 appears in Exhibit B. This Registration is current, valid and subsisting.

5. By reason of the high quality of goods bearing the MEDEFIL and MEDEFLUSH’s marks, along with the extensive use, marketing, publicity, advertising, promotion and resulting public recognition associated with these marks, the MEDEFIL and MEDEFLUSH marks have acquired and built substantial secondary meaning and distinctiveness which represents extremely valuable goodwill to Medefil.

6. In Application No. 86/338165 filed July 15, 2014, the Applicant seeks registration of the mark MEDFIL Design for “platform as a service (PAAS) featuring computer software platforms for use by others for use in medical practice management, electronic health records management, revenue cycle management, and medical billing in the field of healthcare; Software as a service (SAAS) services featuring software for use by others for use in medical practice management, electronic health records management, revenue cycle management, and medical billing in the field of healthcare.”

7. On information and belief, the earliest date of actual or constructive use for the services specified in the subject application upon which the Applicant can rely is July 15, 2014, the filing date of the subject application.

8. Applicant was also the owner of prior application Serial No. 86/168438 for the mark MEDFIL which is opposed by Opposer in Opposition No. 91/218519 which resulted in a judgment in favor of Opposer on January 30, 2015.

9. On information and belief, the subject application was filed by the Applicant shortly after the Applicant became aware of the Opposer's concern over that prior Application.

10. On information and belief, Medefil's priority in its MEDEFIL and MEDEFLUSH marks and the Medefil trade name are earlier than any priority that the Applicant can establish in its MEDFIL Design mark.

11. The Applicant's adoption and alleged use of the MEDFIL Design mark has been without the consent or permission of Medefil.

12. On information and belief, the Applicant's adoption of its MEDFIL Design mark has been with actual or constructive knowledge of Medefil's prior use of and rights in the MEDEFIL and MEDEFLUSH marks and the Medefil trade name.

13. On information and belief, the services specified in the MEDFIL Design application are closely related to the goods Medefil provides and has specified in its issued U.S. trademark registrations in connection with the MEDEFIL and MEDEFLUSH marks and the Medefil trade name.

14. On information and belief, the services specified in the MEDFIL Design application are marketed and sold to the same or related customers in the same or related channels of trade as the goods Medefil provides and has specified in its issued U.S. trademark registrations in connection with the MEDEFIL and MEDEFLUSH marks and the Medefil trade name.

15. The MEDFIL Design mark for which the Applicant seeks registration is substantially similar and confusingly similar to the MEDEFIL and MEDEFLUSH marks and the Medefil trade name.

16. If the Applicant is granted registration of its MEDFIL Design mark as shown in Application No. 86/338165, the Applicant will thereby obtain the *prima facie* exclusive right to use the MEDFIL Design mark, and such registration of the MEDFIL Design mark will impair, diminish, and dilute Medefil's goodwill and rights in its MEDEFIL and MEDEFLUSH marks and the Medefil trade name causing irreparable injury to Medefil.

17. The Applicant's MEDFIL Design mark is confusingly similar to the MEDEFIL and MEDEFLUSH marks and the Medefil trade name and use of the MEDFIL Design mark for the services specified in Application No. 86/338165 will cause the likelihood of confusion, mistake, or deception that the Applicant's services are endorsed, sponsored, or approved by Medefil.

COUNT II: DILUTION

18. Medefil hereby incorporates the allegations contained in paragraph nos. 1-17 by reference herein.

19. Medefil's MEDEFIL and MEDEFLUSH marks and Medefil trade name are widely recognized by the general consuming public of the United States as a designation of source of Medefil's goods. Medefil holds ISO 13485 and 9001 certification and CE approval for its products. In addition to the United States, Medefil sells its goods in Canada as well as the European Union.

20. Medefil's MEDEFIL and MEDEFLUSH marks and Medefil trade name are famous as the term is defined in 15 U.S.C § 1125(c) and were famous as early as 1998 which is prior to the filing of the subject application or prior to any use of the mark by the Applicant.

21. Medefil has expended substantial monies in marketing, advertising and promoting its aforesaid MEDEFIL and MEDEFLUSH marks in connection with the recited goods and Medefil trade name.

22. Medefil possess extremely valuable goodwill in the MEDEFIL and MEDEFLUSH marks by reason of its extensive use, marketing, publicity, advertising and geographic extent of its use and promotion.

23. Applicant's MEDFIL Design mark is likely to cause dilution and to impair the distinctiveness of Medefil's famous MEDEFIL and MEDEFLUSH marks and Medefil trade name whereby Medefil will be damaged by the registration of Applicant's proposed mark on the Principal Register of the United States Patent and Trademark Office.

REQUEST FOR RELIEF

WHEREFORE, Medefil prays that this Opposition be sustained, that Application No. 86/338165 be rejected, that registration of the MEDFIL Design mark be refused, and that Medefil be awarded such further relief as this Board deems just and proper.

Respectfully submitted,

April 22, 2015



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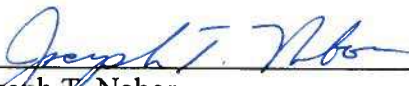
CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid, upon:

Messias Bassile
156 Weatherstone Dr
Woodstock, Georgia 30188-4478

on this 22nd day of April, 2015.

FITCH, EVEN, TABIN & FLANNERY LLP



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678152_1

EXHIBIT A



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MEDEFIL

Word Mark	MEDEFIL
Goods and Services	IC 005. US 006 018 044 046 051 052. G & S: Syringes sold filled with saline and syringes sold filled with heparin. FIRST USE: 19980217. FIRST USE IN COMMERCE: 19980217
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77325534
Filing Date	November 9, 2007
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	April 15, 2008
Registration Number	3457826
Registration Date	July 1, 2008
Owner	(REGISTRANT) Medefil, Inc. CORPORATION ILLINOIS 250 Windy Point Drive Glendale Heights ILLINOIS 60139
Attorney of Record	Joseph T. Nabor
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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MEDEFLUSH

Word Mark	MEDEFLUSH
Goods and Services	IC 005. US 006 018 044 046 051 052. G & S: Syringes sold filled with saline and syringes sold filled with heparin. FIRST USE: 20080910. FIRST USE IN COMMERCE: 20080910
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77321652
Filing Date	November 5, 2007
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	April 15, 2008
Registration Number	3588352
Registration Date	March 10, 2009
Owner	(REGISTRANT) Medefil, Inc. CORPORATION ILLINOIS 250 Windy Point Drive Glendale Heights ILLINOIS 60139
Attorney of Record	Joseph T. Nabor
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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